Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES R. WOODRUFF and PETER J. HESKETH

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Appeal No. 2001-1055
Application No. 08/651,927

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ON BRIEF

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Before BARRETT, GROSS, and LEVY, ***Administrative Patent Judges***.
GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, 11 through 17, 20, 22 through 32, 34, and 35. Claim 10 has been allowed. Claims 18, 19, 21, and 33 have been canceled.

Appellants' invention relates to a method and apparatus for detecting and measuring forces with mechanical resonators. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A vibrating beam force transducer for an accelerometer comprising:

at least a first vibrating beam having a longitudinal axis, first and second fixed end portions and a resonating portion therebetween, said resonating portion defining a lateral wall and having one or more fingers formed substantially coplanar with said beam and projecting from said lateral wall; and

an electrode positioned adjacent to and spaced from said beam for generating an electrostatic force to vibrate said resonating portion of said beam in a transverse direction, said electrode having one or more fingers extending toward said resonating portion of said beam.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tang et al. (Tang)	5,025,346	Jun. 18, 1991
Kulcke et al. (Kulcke) (German patent)	DE 4424635	Jan. 18, 1996

Claims 1 through 4, 7, 9, 11 through 15, 17, 22 through 25, 28, 31, and 34 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Kulcke.

Claims 5, 6, 20, 29, 30, 32, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kulcke.

Claims 8, 16, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kulcke in view of Tang.

Reference is made to the Examiner's Answer (Paper No. 44, mailed December 7, 2000) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No.

42, filed October 6, 2000) and Reply Brief (Paper No. 45, filed February 14, 2001) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will affirm the anticipation rejection of clams 1 through 4, 7, 9, 11 through 15, 17, 22 through 25, 28, 31, and 34 and the obviousness rejections of claims 5, 6, 8, 16, 20, 26, 27, 29, 30, 32, and 35.

The sole issue in this case is whether the Declarations of Mr. Woodruff dated April 1, 1999 and November 19, 1999 show that the invention was actually reduced to practice prior to January 18, 1996, the effective date of the Kulcke reference, thereby removing Kulcke as prior art. We find that the Declarations are insufficient because they fail to meet the requirement that all of the inventors must sign the Declaration. See MPEP § 715.04. Accordingly, we will sustain the examiner's rejections. However, in the interest of judicial economy, we will address the concerns raised by the examiner as to the sufficiency of the Declarations.

The examiner (Answer, page 4) asserts that "a general allegation by the inventor that the invention was completed prior to the date of the reference is insufficient to establish an actual reduction to practice." The examiner also contends that "there is no corroborating evidence that the lab produced the device prior to the effective date of the Kulcke reference." In addition, the examiner argues (Answer, page 5) that the Supplemental Declaration is deficient because the date has been blacked out.

MPEP § 715.07 (8th ed., Rev. 1, Feb. 2003) states that "[w]hen alleging that conception or reduction to practice occurred prior to the effective date of the reference, . . . if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date." Since Mr. Woodruff did allege that the acts referred to occurred prior to January 18, 1996 in the body of the Declaration and the Supplemental Declaration, the date has been established. Furthermore, the second to last paragraph of MPEP § 715.07 states that no corroboration evidence is necessary for a declaration under 37 C.F.R. § 1.131 unless involved in an interference.

Since there is no interference, no corroborating evidence is necessary.

The examiner contends (Answer, page 5) that "there is no evidence that the device worked for its intended purpose" and that "it is not clear what the test results show" in the Supplemental Declaration. The examiner repeats (Answer, page 6) that "it is not apparent from the test results that the device worked for its intended purpose, namely for measuring the acceleration of a proof mass along a fixed axis." However, since appellants filed a patent application subsequent to the test, it is implied that the test showed that the device functioned for its intended purpose. If the test did not show that the device functioned, why would appellants then file for a patent? Accordingly, we find that the Declarations would show actual reduction to practice if signed by both inventors. However, since they were not signed by both inventors, we will sustain the rejections.

CONCLUSION

The decision of the examiner rejecting claims 1 through 4, 7, 9, 11 through 15, 17, 22 through 25, 28, 31, and 34 under 35 U.S.C. § 102(a) and claims 5, 6, 8, 16, 20, 26, 27, 29, 30, 32, and 35 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

LEE E. BARRETT Administrative Patent Judge	)
ANITA PELLMAN GROSS Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

APG:clm

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